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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/559,261	04/27/2000	Shuji Nakamura	122.1407	2241

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EXAMINER

EISEN, ALEXANDER

ART UNIT PAPER NUMBER

2674

DATE MAILED: 07/20/2004

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/559,261

Applicant(s)

NAKAMURA ET AL.

Examiner

Alexander Eisen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,7-10 and 15-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7,15,16 and 19 is/are allowed.
- 6) ☒ Claim(s) 8-10,17,18 and 20-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.



ALEXANDER EISEN
PRIMARY EXAMINER
TECHNOLOGY CENTER 2600

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 8-10, 17, 18 and 20-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not provide for the combination of the limitations “in a rotatable manner” and “as an exclusive support for the pointing device” in the independent claims 8, 9, 17 and 18. The specification actually teaches (p. 20, ll. 22-31) an additional support for the pointing device, in which case it is preferable to make the connector rotatable (see amendment to the original specification p. 21, ll. 6-20).
3. The prior art based rejections of claims 8-10, 17, 18 and 20-23 are not made at this point pending resolving 35 USC 112(1) issues.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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5. Claim 1 is rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Niino (reference of record).

Niino discloses a pointing device comprising a base part (housing 32), an operating part supported on said base part in a rocking manner about a fulcrum, a magnet (46-48) carried on operating part, a magneto-electric transducer (49-52); and an elastic member (a rubber 42 with diaphragms 44) arranged between the base part and the operating part and fixedly supported on said base part (upper part of diaphragms 44 against the housing 32), the elastic member further including an opening (hole 43) for receiving a fulcrum.

Niino also discloses that a resilient member can be a leaf spring, which would be an equivalent to a plate spring and as can be seen from FIGS. 3-4 the plate spring 42 includes a distal free end (outer skirt of the plate 42) engageable with the operating part (disk 36), a proximal end (the inner part of plate 42 close to the opening 43) integrally joined to said first section at a position remote from said distal free end and has a length between the distal; and proximal ends for exerting a spring action.

Allowable Subject Matter

6. Claims 7, 15-16 and 19 are allowed.

7. The reasons for allowance are clear from the record and have been conveyed to the applicant in the previous Office action.

Response to Arguments

8. Applicant's arguments with respect to claims 1, 8, 9, 17 and 18 have been fully considered but are not persuasive. Applicant argues that none of the references teaches the embodiment, wherein "the connector part that serves to electrically and mechanically support, in

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a rotatable manner, the operating part and the detecting part relative to the data processor, also serves as the exclusive support for the pointing device, on the data processor". Applicant further asserts that this feature is supported by the original specification on page 19, lines 26-37 - page 20, line 1. Examiner respectfully disagrees. Firstly, nowhere in the specification the applicant stated that the connector part is an exclusive support for the pointing device on the data processor. Secondly, the specification is actually teaching an additional support for the pointing device, such as a support section 150 located on the body of the data processor and a counterpart engaging section 138 (practically a notch, as can be seen from FIGS. 10B, 11B) located on the pointing device. While the specification teachings on page 20, lines 22-24 cite that "The pointing device 100 may further include an engaging section 138..." seemingly implying that the engaging section is not really a necessity, there is no implication or fair suggestion that the connector part should be supportive in a rotatable manner at this time. The rotatable feature of the connector part is only finds its first mentioning farther in the specification (page 21, lines 6-20; amended by the amendment filed on 30 September 2002; paper #8) in conjunction with the support section 150 and the engaging section 138, and it is cited as means to alleviate connecting procedure by adding the rotatable feature to the connector part when the connector part is provided with support. So the rotating feature is only needed when the connector part is equipped with an additional support, and therefore the language in claims citing "exclusive support" next to "rotatable manner" does not have support in the specification, the disclose does not provide for the connector part without an additional support and having rotatable feature. On the other hand, such combination would be hardly feasible, because it would be quite awkward to operate the pointing device capable of rotation while the latter is not in stable fixed position.

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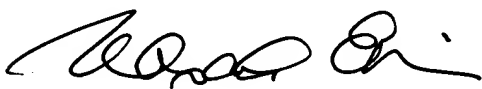
9. Therefore the claims 8-10, 17, 18 and 20-23 have been rejected under 35 USC 112(1) as containing a new subject matter. No prior art based rejections are made at this point pending applicant's response with an amendment to claims, which would obviate the above rejections.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Eisen whose telephone number is (703) 306-2988. The examiner can normally be reached on M-F (8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard A. Hjerpe can be reached on (703) 305-4709. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alexander Eisen
Primary Examiner
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15-Jul-04